



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/328,066	06/08/1999	STEPHEN WILLIAM HILLIER	0500.01326	6282

23418 7590 01/05/2004

VEDDER PRICE KAUFMAN & KAMMHOLZ
222 N. LASALLE STREET
CHICAGO, IL 60601

EXAMINER

LANIER, BENJAMIN E

ART UNIT	PAPER NUMBER
----------	--------------

2132

DATE MAILED: 01/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/328,066

Applicant(s)

HILLIER ET AL.

Examiner

Benjamin E Lanier

Art Unit

2132

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 December 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-33 and 35-47 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 10-12, 18-44 is/are rejected.
- 7) ☒ Claim(s) 6-9, 13-17 and 45-47 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 June 1999 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. Applicant's amendment of claim 2 has been fully considered and is entered.

Response to Arguments

2. Applicant's arguments filed 03 December 2003 have been fully considered but they are not persuasive. Applicant's argument that the Appelbaum reference does not disclose a first party is not persuasive because the system of Appelbaum is software related; therefore the first party would be the software vendor.
3. Applicant's argument that the third party does not receive the double key package is not persuasive because Appelbaum discloses that the triple encrypted key is single decrypted at the computer (second party) before being sent to the module (third party)(Abstract). Therefore, the module is receiving a double key package, and the computer single decrypted what would be an encrypted double key package.
4. Applicant's argument that Appelbaum reference does not disclose the recovery of a decryption key for the second party using a third party based decryption key is not persuasive because module program performs a decryption, using its own key, on the double key package to obtain the unique key which allows the computer (second party) to utilize the protected program (Abstract).
5. Applicant's argument that the Appelbaum reference does not disclose using three encryption keys is not persuasive because Appelbaum discloses a triple encrypted key. Ki is a key that is described and there are different FK keys described for different computers (Col. 2, lines 40-50).

Art Unit: 2132

6. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1-5, 10, 12, 18, 19, 23, 24, 27, 32, 33, 35-37, 40-44 are rejected under 35 U.S.C. 102(b) as being anticipated by Appelbaum, U.S. Patent No. 4,683,968. Referring to claims 1-5, 10, 12, 18, 19, 23, 24, 27, 32, 33, 35-37, 40-44, Appelbaum discloses a system for preventing software piracy wherein a protected program can be run on only a selected number of computers and there is a unique key for each computer. The key being triple encrypted (double key package), and the triple encrypted key is sent to the computer (second party) where a single decryption procedure is performed by a checker program at the computer and the result is sent to a module (third party). The module performs a single decryption procedure and sends the result back to the computer (second party). The check program at the computer then performs another single decryption procedure on it to obtain the unique key which allows the computer to utilize the protected program (Abstract).

Claim Rejections - 35 USC § 103

Art Unit: 2132

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 11, 25, 26, and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Appelbaum, U.S. Patent No. 4,683,968, in view of Perlman, U.S. Patent No. 5,351,295.

Referring to claims 11, 25, and 26, Appelbaum discloses a system for preventing software piracy wherein a protected program can be run on only a selected number of computers and there is a unique key for each computer. The key being triple encrypted (double key package), and the triple encrypted key is sent to the computer (second party) where a single decryption procedure is performed by a checker program at the computer and the result is sent to a module (third party). The module performs a single decryption procedure and sends the result back to the computer (second party). The check program at the computer then performs another single decryption procedure on it to obtain the unique key which allows the computer to utilize the protected program (Abstract). Appelbaum does not disclose providing a time stamp with the data. Perlman discloses a time stamp that is encrypted and sent along with the data (Col. 2, lines 53-59). It would have been obvious to one of ordinary skill in the art at the time the invention was made to include a time stamp in the system for preventing software piracy of Appelbaum in order to prevent attacks on the data as discloses in Perlman (Col. 2, lines 49-59).

11. Claims 20-22, 28-30, 38, 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Appelbaum, U.S. Patent No. 4,683,968, in view of Wertheimer, U.S. Patent No. 5,920,630.

Referring to claims 20-22, 28-30, 38, 39, Appelbaum discloses a system for preventing software

Art Unit: 2132

piracy wherein a protected program can be run on only a selected number of computers and there is a unique key for each computer. The key being triple encrypted (double key package), and the triple encrypted key is sent to the computer (second party) where a single decryption procedure is performed by a checker program at the computer and the result is sent to a module (third party). The module performs a single decryption procedure and sends the result back to the computer (second party). The check program at the computer then performs another single decryption procedure on it to obtain the unique key which allows the computer to utilize the protected program (Abstract). Appelbaum does not disclose digitally signing the transmissions from party to party or verifying that the transmissions were received. Wertheimer discloses a method of public key cryptography wherein cryptographic keys are exchange between users and a certifying authority in order to promote secure communication and the message distributions in the system are signed and verifiable via a directory of transmissions (Abstract, Col. 10, lines 10-33). It would have been obvious to one of ordinary skill in the art at the time the invention was made to digitally sign the transmissions of Appelbaum and have them verifiable that way the parties in the system of Appelbaum would be able to verify the identity of the transmitter as well as verify that transmissions were received as taught in Wertheimer (Col. 10, lines 10-33, Col. 6, lines 40-50).

Allowable Subject Matter

12. Claims 6-9, 13-17, 45-47 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

13. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Conclusion

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Benjamin E Lanier whose telephone number is 703-305-7684. The examiner can normally be reached on M-Th 7:30am-5:00pm, F 7:30am-4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gilberto Barron can be reached on (703)305-1830. The fax phone number for the organization where this application or proceeding is assigned is 703-746-7239.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.



THOMAS R. PEESO
PRIMARY EXAMINER